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IN THE  
Supreme Court of the United States

OCTOBER TERM, 1942

No. 309

MARCONI WIRELESS TELEGRAPH COMPANY  
OF AMERICA,

*Petitioner,*

*vs.*

THE UNITED STATES,

*Respondent.*

REPLY BRIEF FOR PETITIONER IN SUPPORT  
OF PETITION FOR WRIT OF CERTIORARI

ABEL E. BLACKMAR, JR.,

RICHARD A. FORD,

*Counsel for Petitioner.*

December, 1942

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vs.

THE UNITED STATES,

*Respondent.*

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**REPLY BRIEF FOR PETITIONER IN SUPPORT  
OF PETITION FOR WRIT OF CERTIORARI**

Most of the arguments set forth in respondent's brief were anticipated in the petition and supporting brief and are there, we believe, fully answered. We will therefore here confine ourselves to two of the subjects discussed in respondent's brief.

(1) **There is adequate basis for review under the Act of February 13, 1925, as amended May 22, 1939:**

Section 3 of the Act of February 13, 1925 (U. S. Code, Title 28, section 288), *prior to the amendment of 1939*, provided that none of the evidence in a case before the Court of Claims should be included in the transcript of record on petition to this Court for a writ of certiorari. The record

We submit that the 1939 amendment made the decisions of this Court in cases like *Thomson Co. v. Ford Motor Co.*, 265 U. S. 445, 447, and *Sanitary Co. v. Winters*, 280 U. S. 50, 56, applicable to cases brought here from the Court of Claims. These cases pointed out, first, that the general rule, on review of decisions of circuit courts of appeals (as on review of decisions of the Court of Claims), is that concurrent findings of the lower courts on questions of fact will be accepted by this Court unless clear error is shown; it was then said, in the *Thomson* case (265 U. S., at p. 447):

"We think, however, that this rule should not be strictly applied in cases brought here because of a conflict of decision in the different circuit courts of appeal, and have therefore given consideration to the question as to which of the decisions upon this question of fact, in the light of the prior art, is based upon the sounder reasoning."

Where two courts have reached diametrically opposed conclusions on substantially the same evidence, the question as to which conclusion is correct becomes, we submit, in effect a question of law.

(2) **The decision of the Court of Claims herein that claims 1, 2, 3, 6, 8, 10-14, and 17-20 of Marconi patent No. 763,772 were invalid and that claims 1 and 37 of the Fleming patent had not been infringed was in direct conflict with prior decisions of other courts, including circuit courts of appeals:**

(a) As to the decision in *Marconi Wireless Telegraph Company of America v. Kilbourne & Clark Mfg. Co.*, 239 Fed. 328, affirmed 265 Fed. 644 (Circuit Court of Appeals for the Ninth Circuit), respondent asserts (brief, p. 11) that the so called "Stone defense" was presented solely to sustain the defense of noninfringement of the invention as

united by the prior art,"—seeking thus to explain away the specific holding in the decree in that case that the Marconi patent No. 763,772 was valid. Respondent's assertion is not in accord with the facts.

The defendant in the *Kilbourne & Clark* case devoted over 90 pages of its brief before the district court to an attempt to show "prior invention" and "prior knowledge" of the subject matter of the Marconi patent by Stone; the conclusion stated in the brief was that "In all essentials Stone is an exact anticipation of Marconi." (Brief for Defendant, p. 212.)

Similarly, over 50 pages of defendant's appeal brief, in the *Kilbourne & Clark* case, was devoted to the alleged anticipatory character of the "Stone defense", defendant's conclusion reading—

"The Stone anticipation ought to be conclusively adjudicated now by effectuating the favorable Stone dicta of the Court below and declaring the Marconi patent invalidated by Stone; because while defendants commercial apparatus is so clearly non infringing, yet the validity issue may become important in connection with apparatus made for the government on its specifications." (Brief for Kilbourne & Clark Mfg. Co., p. 435.)

The so called "Stone defense" was therefore litigated in the *Kilbourne & Clark* case on the issue of validity. As the Marconi patent was there held valid, the decision of the Court of Claims herein is in direct conflict therewith.

Likewise, the Tesla patent, No. 645,576, was considered at length in defendant's briefs in the *Kilbourne & Clark* case,—both before the district court and before the circuit court of appeals; and, of course, the Lodge patent, being in suit in that case, was also before both courts. As to the Tesla patent, the defendant in that case argued that—

"This is a complete anticipation of all the fundamentals of the four tuned circuit radio telegraph system of plaintiff's patent, wherein a 'closed' circuit is coupled by a transformer to a grounded antenna at each station." (Brief on appeal for Kilbourne & Clark Mfg. Co., p. 333.)

In view of the foregoing, respondent's argument that the adjudication of validity of the Marconi patent in the *Kilbourne & Clark* (and other) cases is not inconsistent with the result reached below, is clearly erroneous,—the same prior art having admittedly been before both courts.

Regardless of what respondent may say, the fact remains that the Marconi patent was held valid in all of the cases referred to in our petition herein (pp. 4-5) and was held invalid, as to claims 1, 2, 3, 6, 8, 10-14, and 17-20, by the court below.

(b) As to the Fleming patent, respondent is also in error in arguing that the prior *DeForest* case on that patent did not involve "the question of infringement here presented." As respondent admits (brief, p. 7), its alleged infringement consisted in the use of "the DeForest three-element vacuum tubes as detectors and amplifiers." Similarly, the alleged (and adjudicated) infringement in the case of *Marconi Wireless Telegraph Company of America v. DeForest Radio Tel. & Tel. Co.*, 236 Fed. 942, affirmed 243 Fed. 566 (Circuit Court of Appeals for the Second Circuit), was the use of DeForest three-element vacuum tubes as detectors.<sup>1</sup>

<sup>1</sup>Their use as amplifiers and as generators of oscillations was before the district court only, the adjudication of infringement in those subsequent decrees not having been appealed by defendant. (See p. 22 of our brief in support of our petition for certiorari.)

Again, the fact remains that the Second Circuit Court of Appeals held that claims 1 and 37 of the Fleming patent were infringed by the use of DeForest three-element vacuum tubes as detectors, whereas the court below held directly to the contrary.

(c) It is to be noted that respondent does not suggest that the *evidence* in the present case differs from that in the prior cases, but merely that the positions taken or arguments made by the parties have been different. Thus, respondent's argument is tantamount to saying that, in order to avoid the effect of a prior decision, it is only necessary to make a new argument on the same evidence.

As the issues in the prior cases were the same as in the present case and as the evidence was substantially the same, we submit that there is no sound basis for arguing, as respondent does, that the prior adjudications were not inconsistent with the results reached below.

### CONCLUSION

**We respectfully urge that plaintiff's petition for a writ of certiorari herein be granted.**

Respectfully submitted,

ABEL E. BLACKMAR, JR.,  
 RICHARD A. FORD,  
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December, 1942.